

REMARKS/ARGUMENTS

Favorable reconsideration of the above-identified patent application, in light of the above amendments and the following remarks is respectfully requested. The presently pending claims are claims 1-17. Claims 1, 14, and 15 have been amended. Claim 17 has been added.

In paragraphs 1 and 2 of the Office Action, the Examiner rejected claims 1-9, 15, and 16 under 35 U.S.C. 102 (b) as being anticipated by U.S. Patent No. 6,398,136 to Smith (Smith). In response, the Applicant has amended independent claims 1 and 15 to better differentiate Applicant's invention from Smith. Smith discloses a fire fighting penetration tool having a penetrating body, hollow handle, and apertures. The Applicant's invention, on the other hand, includes a *planar surface area* to limit the penetration of the penetrating body into a surface. Smith does not disclose a planar surface area for limiting the penetration of the penetrating body into a surface.

In addition, the Applicant respectfully disagrees that Smith anticipates the Applicant's invention. Smith merely discloses a penetrating body without the key element of a planar surface area, as claimed by the Applicant. For prior art to anticipate under Section 102, every element of the claimed invention must be identically disclosed, either expressly or under principles of inherency, in a single reference. *Corning Glass Works v. Sumitomo Electric*, 9 U.S. P.Q. 2d 1962, 1965 (Fed. Circ. 1989). The exclusion of a claimed element, no matter how insubstantial or obvious, from a prior art reference is enough to negate anticipation. *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Circ. 1983). In regards to inherency, inherency may be relied upon where, but only where, the consequence of following the reference disclosure always inherently produces or results in the claimed invention. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 313 (Fed.

Circ. 1983). If there is not a reasonable certainty that the claimed subject matter will necessarily result, the rejection fails. *In re Brink*, 164 U.S.P.Q. 247 (CCPA 1970). Also, accidental results, not intended and not appreciated, do not constitute an anticipation. *Georgia-Pacific Corp. v. United States Plywood Corp.*, 118 U.S.P.Q. 122, 128 (2nd Circ. 1958). It should be noted that Smith does not mention anything relating to a planar surface area or problems associated with limiting the penetration of a surface area. It should also be noted that the planar surface area refers to reference number 16 in FIG. 1 of the Applicant's application.

Claims 2-9 depend from independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. In addition, claim 16 depends from independent claim 15 and recites additional limitations in combination with the novel elements of claim 15. Therefore, the withdrawal of the rejection and the allowance of claims 1-9, 15, and 16 is respectfully requested.

In paragraphs 3 and 4 of the Office Action, the Examiner rejected claims 10-12 and 14 under U.S. C. 103(a) as being unpatentable over Smith in view of U.S. Patent No. 2,993,650 to Badberg (Badberg). In response, the Applicant has amended independent claims 1 and 14 to better differentiate Applicant's invention from Smith and Badberg. Smith does not teach or suggest a planar surface area to limit the penetration of a penetrating body into a surface. The combination of Smith and Badberg does not teach or suggest all the elements of claims 10-12 and 14.

In regards to the comments made on claim 11 by the Examiner, the Applicant respectfully disagrees. The Examiner stated it would have been obvious to one of ordinary skill in the art to have made the weight so that the head weighs more than the handle so as to have sufficient strength to drive the tool when needed. However, this is not correct. A weighted head is only advantageous for

a penetrating tool that is to be swung, such as the motion that takes place when one swings an axe. For the penetrating tool disclosed in Smith, the tool is driven into the surface with a force directly aimed at the surface. Smith's penetrating tool is not swung like an axe. In fact, it would be impossible to swing Smith's penetrating tool like an axe. Weight in the head of Smith's penetrating tool would provide no benefit to the operator of the tool because there is no momentum provided by a swinging motion. For prior art references to be combined to render obvious a subsequent invention under Section 103, there must be something in the prior art as a whole which suggests the desirability, and thus the obviousness, of making the combination. *Uniroyal v. Rudkin-Wiley*, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). The teachings of the references can be combined only if there is some suggestion or incentive in the prior art to do so. *In re Fine*, 5 U.S.P.Q.2d at 1599. Hindsight is strictly forbidden. It is impermissible to use the claims as a framework from which to pick and choose among individual references to recreate the claimed invention. *Id.* At 1600; *W.L. Gore*, 220 U.S.P.Q. at 312. Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Circ. 1992); *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Therefore, it would not have been obvious to have a weighted head.

Claims 10-12 depend from amended independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. Therefore, the withdrawal of the rejection and the allowance of claims 10-12 and 14 is respectfully requested.

In paragraph 5 of the Office Action, the Examiner rejected claims 12-14 under U.S. C. 103(a) as being unpatentable over Smith in view of U.S. Patent No. 551,527 to Cunningham (Cunningham). The Examiner stated that Smith shows all of the claim limitations but does not show a stream adapter. The Examiner also stated that Cunningham shows another nozzle having a stream adapter. The Examiner said it would have been obvious to one of ordinary skill in the art to have made Smith's fire fighting tool with a stream adapter so as to be able to direct the stream so as not to strike the user as suggested by Cunningham. In response, the Applicant has amended independent claims 1 and 14 to better differentiate Applicant's invention from Smith and Cunningham. As discussed above, neither Smith nor Cunningham teaches or suggests a penetrating body having a planar surface area to limit the penetration of the penetrating body through a surface. In addition, as to the comments by the Examiner that the weighted head would inherently have to weigh more than the remainder of the handle, the Applicant respectfully disagrees. Since Smith does not disclose a penetrating tool that is swung, there is no advantage to having a weighted head. The weight may be evenly distributed throughout the tool and still perform in the same manner. Additionally, with weight in the front of this in-line penetrating tool, the tool would be cumbersome when trying to strike a surface. Rather than weighting the surface for the in-line penetrating tool, it would be preferred to provide a weight evenly distributed throughout the tool.

Claims 12 and 13 depend from amended independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. Therefore, the withdrawal of the rejection and the allowance of claims 12-14 is respectfully requested.

In paragraph 6 of the Office Action, the Examiner rejected claims 1-6 and 10-16 under U.S.C. 103(a) as being unpatentable over Badberg in view of U.S. Patent No. 4,170,948 to Strickland, Jr. (Strickland). The Examiner stated that Badberg shows a fire fighting tool having a hollow handle, penetrating body, holes, threaded portions, shut off valve, penetrating surface and stream adapter. The Examiner also stated that Strickland shows another penetrating device with a weighted head 30. The Examiner also stated that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a weighted head on Badberg's device so as to be able to shield the operator from spray and to balance the apparatus so as to prevent excessive shaking from the water passing through during use.

In response, the Applicant has amended independent claims 1, 14, and 15 to better differentiate Applicant's invention from Badberg and Strickland. Neither Badberg nor Strickland teach or suggest a planar surface area to limit the penetration of the penetrating body through the surface. In addition, the Applicant respectfully disagrees that Strickland is an appropriate reference. Strickland discloses an apparatus for injecting fluid in soil, which is in a non-analogous art. Strickland device is merely a gardening tool for injecting fluid into the soil. The Applicant's invention is specifically for use in fighting fires. Fire fighting devices and garden tools do not perform the same or similar functions and thus are not of an analogous field. Specifically, the Examiner mentions the "weighted head 30" of Strickland. Reference number 30 in Strickland is merely a splash guard to prevent the fluid from striking the operator (col. 2, lines 53-60). The Applicant's claimed invention does not have such a splash guard. The Examiner, within the entire Office Action, has brought up the element of preventing water or fluid from hitting the operator.

However, when fighting a fire, there is no need to provide such as splash guard. It is not a concern or a problem for firefighters.

In regards to the possible argument that the splash guard 30 of Strickland being used as a reference to show a planar surface area, Strickland does not teach or suggest using the splash guard to prevent the penetration of the device into the ground. The sole purpose is to prevent fluid from striking the operator.

Claims 1-6 and 10-13 depend from amended independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. Claim 16 depends from amended independent claim 15 and recites additional limitations in combination with the novel elements of claim 16. Therefore, the withdrawal of the rejection and the allowance of claims 1-6 and 10-16 is respectfully requested.

In paragraph 7 of the Office Action, the Examiner rejected claims 7-9 under U.S.C. 103(a) as being unpatentable over Badberg in view of Strickland and further in view of Smith. The Examiner stated that the combination of Badberg and Strickland does not show the penetrating body having a groove. The Examiner stated that Smith shows another penetrating body having grooves. The Examiner further stated that it would have been obvious to put grooves as shown on Smith's tool on the penetrating body so as to be able to change the pattern of the spray such that the pattern will cover a larger area.

In response, the Applicant has amended independent claim 1 to better differentiate Applicant's invention from the cited references. As discussed above, none of the references teach or suggest a planar surface area to limit the penetration of the penetrating body into a surface.

Claims 7-9 depend from amended independent claim 1 and recite additional limitations in combination with the novel elements of claim 1. Therefore, the withdrawal of the rejection and the allowance of claims 7-9 is respectfully requested.

The Applicant has also added claim 17 to claim the novel feature of a penetrating body protruding from the hand at an approximately ninety degree angle. Having this angle on the penetrating body enables the firefighter to swing the tool into the surface, using the momentum of the weighted head to penetrate a surface. No other reference includes such a configuration.

CONCLUSION

For all the above reasons, the Applicant respectfully requests the reconsideration and withdrawal of the rejection and the allowance of claims 1-17.

Respectfully submitted,


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